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7590

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EXAMINER

SHAFFER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 06/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/693,612

Applicant(s)

CHASE ET AL

Examiner

R D SHAFFER

Group Art Unit

2872

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 4/8/02

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above claim(s) 8-11 AND 16-19 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7, 12-15 AND 20-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7/1/8

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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1. Applicant's election with traverse of Species "A" in Paper No. 11 is acknowledged. The traversal is on the ground(s) that there would be no "serious burden" on the examiner to examine all of the non-elected species along with the elected species because the examiner failed to show that the various species fall into different art classes. This is not found persuasive because the restriction requirement set forth in Paper No. 10 is based on the fact that the claimed species are independent inventions and MPEP 808.01(a) clearly states that "it is not necessary to show separate status in the art or separate classification" for two or <sup>more</sup> patentably distinct species. Moreover, continued search and examination of claim(s) to a non-elected species having substantially different structural limitations is a prima facie showing of burden. Applicant may overcome the requirement for restriction by presenting an allowable linking claim or by providing a clear admission on the record that the claim(s) drawn to a given non-elected species is not patentably distinct from the elected species.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-11 and 16-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a nonelected species, the requirement having been traversed in Paper No. 11.

3. Claims 7 and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, as originally filed, fails to provide an enabling disclosure as to how

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to make and/or use the optical micro-electromechanical device to be configured/operates as a laser. The specification fails to teach one of ordinary skill in the art the correlation between the optical micro-electromechanical device and the laser in such a way as to enable one skilled in the art to make and/or use the invention without undue experimentation.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, the use of the language "configured" is vague, indefinite and fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner what is the metes and bounds of the above mentioned language.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was

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not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b).

Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-7, 12-15 and 20-29 are rejected under 35 U.S.C. 102(a) as being anticipated by the Master of Science Thesis entitled "Design and Properties of a Torsional Micromechanical Tunable Optical Filter" by Waite.

Waite discloses all of the subject matter claimed, note Figures 4-6, 12, 15, 16, 24 and 26 along with the associated description thereof.

7. Claims 1, 3, 12, 20 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al ('280).

Miller et al discloses an optical micro-electromechanical device comprising a substrate (18), and a mirror assembly including a torsional beam (16), a cantilever (12), a connector (80-83) and a counterweight (26). Note by example only Fig. 1 and the associated description thereof, wherein cantilever may carry a mirror (see column 5, lines 2-6).

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the substrate, the laser, the optical detector, the optical filter, the optical amplifier and the optical attenuator must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. Any inquiry concerning this communication should be directed to R.D. Shafer at telephone number (703) 308-4813.

RDS

June 12, 2002

*Ricky D. Shafer*  
RICKY D. SHAFER  
PATENT EXAMINER  
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